

REMARKS

Claims 30-60 are all the claims pending in the application, claims 1-29 having been previously canceled.

Claims 30-40 stand rejected under 35 U.S.C. §102(b) as being anticipated by Suzuki (U.S. patent 5,981,859). Claims 41 and 42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Suzuki in view of Lindemann et al. (U.S. patent 5,744,742). Claims 40-60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sgroi (U.S. patent 5,357,048) in view of Fay (2002/0124715) and further in view of Longo (U.S. patent 6,066,794). Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

Rejection Under 35 U.S.C. §102(b)

Suzuki is not available as prior art under 35 U.S.C. §102(b)

The Examiner rejects claims 30-40 under 35 U.S.C. §102(b) as being anticipated by Suzuki. Applicant respectfully points out that the present application is a division of application Ser. No. 09/313,533, now issued patent 6,610,917, which has a filing date of May 15, 1999. The May 15, 1999, filing date of the '917 patent predates the November 9, 1999, issue date of the Suzuki patent. Consequently, the Suzuki patent is not available as prior art under 35 U.S.C. §102(b). Accordingly, Applicant requests that the rejection to claims 30-40 under 35 U.S.C. §102(b) be withdrawn.

Rejection Under 35 U.S.C. §103(a)

Rejection Under 35 U.S.C. §103(a)

The Examiner rejects claims 41 and 42 under 35 U.S.C. §103(a) as being unpatentable over Suzuki in view of Lindemann.

Specificity of Rejection is Inadequate

Claims 41 and 42 depend from independent claim 40. In rejecting claims 41 and 42, the Examiner refers to the claim 40 rejection as identifying the teachings of Suzuki. However, the claim 40 rejection only identifies a single portion of the Suzuki patent as teaching all of the elements of claim 40. Specifically, page 4 of the Action identifies “envelope generator (18),” and does not provide any further guidance as to which portions of Suzuki provide the requisite teachings. Applicant is unable to ascertain which portions of Suzuki are relied upon by the Examiner, and therefore cannot properly address this rejection. Applicant has nevertheless reviewed Suzuki and submits that this reference does not teach or suggest the inventions recited in claims 41 and 42. In the event the Examiner elects to issue a further rejection to claims 41 and 42, Applicant respectfully requests that any such rejection identify the location of the purported teachings of the Suzuki patent, as required by MPEP 707 and 37 CFR § 1.104(c)(2), which is discussed in more detail below.

Official Notice Definition is Inaccurate

On page 5 of the Action, the Examiner takes Official Notice that a “controllable envelope generator” is “a transient generator with a slew limiter.” Applicant respectfully submits that the *offered* definition of a “controllable envelope generator” is most certainly not common knowledge or well-known. Applicant respectfully disagrees with the Examiner on this point and submits that the offered definition of this device is not the commonly accepted meaning.

Applicant is unaware any reference, including those cited in the IDS and other references of record, that defines a "controllable envelope generator" as that set out in the Action. Applicant respectfully requests that the Examiner provide documentary evidence in the next office action if the rejection to the identified claims is to be maintained. (MPEP §2144.3[C], 2100-138 (May 2004); see also 37 CFR § 1.104(c)(2)). In addition, if the Examiner is relying on personal knowledge to support the findings of what is known in the art, the Examiner is further requested to provide an affidavit or declaration setting forth specific factual statements and explanation to support the findings recited in the Office Action. See 37 CFR § 1.104(d)(2).

Rejection Under 35 U.S.C. §103(a)

Claims 40-60 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sgroi in view of Fay and further in view of Longo.

Fay is Unavailable as Prior Art

Applicant submits, once again, that the Office Action presents a rejection using a reference that is unavailable as prior art to the claims of the present application. As set forth above, the present divisional application claims benefit of priority of U.S. patent 6,610,917, which has a filing date of May 15, 1999. The May 15, 1999, filing date of the '917 patent predates the March 7, 2001, filing date of the Fay publication by nearly two years. The Fay publication is not available as prior art under any section of 35 U.S.C. §102, and thus it is improper for the Fay publication to be asserted in the present rejection under 35 U.S.C. §103(a). Applicant further submits that neither Sgroi, Longo, nor any of the other references of record, supply the requisite teachings for which Fay

purportedly provides. Accordingly, Applicant requests that the rejection to claims 30-40 under 35 U.S.C. §103(a) be withdrawn.

Specificity of Rejection is Inadequate

Notwithstanding the above remarks, and in the event the Examiner elects to issue another rejection using Sgroi and Longo, Applicant provides the following comments. The rejection of claims 40-60 under 35 U.S.C. §103(a) is set out on pages 5-8 of the Action. Applicant first notes that MPEP 707, citing 37 CFR § 1.104(c)(2), provides:

“... When a reference is complex or shows or describes other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claims specified.”

Applicant submits that the rejection presented on pages 5-8 of the Action fails to comply with the requirements of MPEP 707, thus preventing Applicant a fair opportunity to address the rejection. Applicant has thoroughly reviewed this portion of Action, and has discovered that the rejection contains inconsistent statements, appears to reject claims which are no longer pending, fails to identify rejected claims, and does not sufficiently identify the location in the asserted references which contain the purported teachings. Examples of such deficiencies are as follows.

Inconsistent statements: On page 5, starting at the fourth line from the bottom, figures 1 and 3 of Sgroi are used to teach the claim limitation “generating an outgoing MIDI control signal based upon said multiplied value.” However, starting at the first line of page 6, the Examiner utilizes figures 3 and 4 of Sgroi to teach the identical feature. Applicant is unsure which grouping of figures contains the purported teaching.

Rejection of claims that are no longer pending: The rejection to claims 40-60 spans approximately three pages. However, approximately half of this rejection, which is based on the Longo patent, is a near *verbatim* repeat of the rejection presented in the last Office Action in this application (See Office Action dated January 13, 2005, pages 4 and 5). Applicant is concerned that the rejection based upon Longo seems to refer to claim language present in claims that are no longer pending in the present application. Indeed, such claims were canceled in the Amendment filed along with the RCE filed on April 12, 2005.

Rejected claims are not identified: The Action rejects claims 40-60 using three references; Sgroi, Fay, and Longo. The three-page rejection provides the purported teachings of each of these references, but the rejection does not specifically identify the claim numbers in association with the wording of the rejection. The rejection simply identifies the reference, without reference to any particular claim number, and states that the reference discloses a number of features. After an extensive review of the rejection, Applicant discovered that portions of the rejection seem to relate to claims 43, 44, 45, 47, and 49. However, language pertaining to the remaining claims, of the twenty-one rejected claims 40-60, is either not clearly expressed or entirely missing from the Action.

Action does not sufficiently identify locations of the teachings: Undeniably, Sgroi and Longo are lengthy and complex disclosures. However, with regard to Sgroi, the Examiner simply refers to two or more figures as providing the teachings. The identified figures depict a number of different systems, components, and signaling, but the Action does not specify which portion of these figures provides the requisite teaching. Applicant recognizes that the portion of the rejection based on the Longo reference identifies several components by reference number (i.e.,

200, 210). However, as noted above, Longo seems to refer to claim language present in claims that are no longer pending in the present application, and is therefore inapplicable to the present claims.

Patentable Subject Matter

As this is the ninth Office Action in this application, Applicant has had ample opportunity to thorough review all of the cited references including Suzuki, Sgroi, and Longo. These references, alone or in combination, do not teach or suggest the inventions recited in the claims of the present application. Should the Examiner elect to issue another rejection, Applicant respectfully requests that any such rejection comply with, among other things, the requirements of MPEP 707.

Figure for Cover Sheet

Once again, should the Examiner deem the claims of the present application to be allowable, Applicant respectfully requests that Figure 67 be used as the figure for the cover sheet on the issued patent. The Examiner is invited to telephone the undersigned to discuss alternative figures should it be necessary.

Applicant further notes that the application was published with the figures printed in duplicate. Applicant respectfully requests the Examiner's assistance in correcting this matter so that any patent issuing from the present application will only contain a single copy of the figures.

CONCLUSION

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge any fees that arise in connection with this filing which are not covered by the money enclosed, or credit any overpayment, to Deposit Account No. 02-0460.

Respectfully submitted,

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Dated: October 7, 2005

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